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EXAMINER

KARMIS, STEFANOS

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/750,603
Filing Date: December 28, 2000
Appellant(s): HAYES ET AL.

MAILED

AUG 22 2007

GROUP 3600

Joseph D. Dreher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 April appealing from the Office action mailed 08 August 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,516,157

Maruta et al.

2-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18, 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. The term "arbitrarily" in claims 1, 6, 16, 20 and 23 is a relative term which renders the claim indefinite. The term "arbitrarily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examining purposes, the Examiner interprets "arbitrarily" to mean "at least one." Claims 2-5, 7-15, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph because of their dependency on claims, which contain the "arbitrarily" term.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-7, 16, 17 and 19-23 rejected under 35 U.S.C. 102(e) as being anticipated by Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157.

Regarding independent claims 1, 6, 20 and 21, Maruta discloses a configurable billing system for a machine, the machine operative to output a product or a service and including a plurality of aspect sensors, the sensors operative to detect the delivery of aspects of the product or service and to report the delivery to the billing system, the billing system comprising: a coded billing strategy including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions defines for the machine (column 10, lines 1-10); and a plurality of meters updated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy, whereby the billing system tallies the aspects in a manner defined in the billing strategy (column 9, lines 20-53 and column 10, lines 1-10).

Claim 2, the coded billing strategy further comprises information regarding a format in which information regarding the aspect of interest will be communicated to the billing system by the machine (column 11, lines 51-57).

Claim 3, wherein each meter in the list of meters is described as a function of at least one of the listed aspects of interest (column 10, lines 23-34).

Claim 4, wherein the coded billing strategy comprises information associated with the listed meters, the information describing the function of the meters (column 10, lines 43-53).

Claims 5 and 7, wherein the plurality of meters are instantiated in memory, by the billing system, according to the coded billing strategy (column 10, lines 14-21).

Regarding independent claims 16, 19 and 22, Maruta discloses a document processing system comprising: a print engine (column 2, lines 53-57); a configurable billing system operable to follow a billing strategy specification including an arbitrarily long list of document production events of interest, an arbitrarily long list of meter descriptions and a machine readable script for updating the meters defined in the list to record the occurrence of document production events as described in the billing strategy defines for the machine (column 9, lines 20-53 and column 10, lines 1-10); and a marker module operative to control the print engine in the production of documents, and to report document production events to the billing system (column 10, lines 43-63).

Claim 17, wherein the marker module is operative to deliver the billing strategy to the billing system (column 10, lines 43-63).

Regarding independent claim 23, Maruta discloses a document processor operative to produce printed documents, the document processor comprising: a print engine (column 2, lines 53-57); at least one aspect sensor operative to sense and report at least one of an impression count, an impression event, a set count, a diagnostic impression event, a media description, a use of highlight color and a use of full color related to a production of a document (column 9, lines

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20-24); a billing strategy file defining a billing strategy in machine readable form, the billing strategy file describing an arbitrarily large number of mathematical functions of an arbitrarily large number of meters for processing and recording information reported by the at least one aspect sensor (column 10, lines 1-10); a billing module operative to receive the billing strategy file and instantiate the arbitrarily large number of meters according to the billing strategy (column 10, lines 43-63) and a marker module operative to control the print engine in the production of a document (column 10, lines 43-63).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157.

Claims 8-15, Murata teaches that the list of aspects of interest comprises document size, ACS determination result, and the number of documents for each type (column 9, lines 20-24). Murata fails to specify other aspects of interest such as impression count, impression event flag, set count, set completion flag, diagnostic impression flag, media descriptor, highlight color flag or a full color flag. Official Notice is taken that many aspects of interest can be used for billing.

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Murata and include these as aspects of interest in the billing system because they are specialized characteristics upon which cost can be calculated just as with size, color and quantity.

Claim 18, Murata teaches a print engine. Murata fails to teach a xerographic printer. Official Notice is taken that a xerographic printer is old and well known in the arts. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Murata and include xerographic printers because they are commonly used and provide output similar to other print engines on which the billing system is based.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 1-18, 20 and 23 under 35 U.S.C. § 112, second paragraph.

1. Regarding claims 1-18, 20 and 23 Appellant asserts that the term "arbitrarily" used in claims 1, 6, 16, 20 and 23 does not render the claim indefinite because one of ordinary skill in the art would understand that an arbitrarily long list would have a length depending on choice or discretion based on convenient selection or choice (see Appeal Brief, pages 16-21).

In Response: The Examiner respectfully disagrees that the term "arbitrarily" as used in claims 1, 6, 16, 20 and 23 is sufficient to satisfy 35 U.S.C. § 112, second paragraph as argued by

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the Appellant. Claim 1 states “a coded billing strategy including an *arbitrarily* long list of aspects of interest and an *arbitrarily* long list of meter descriptions defined for the machine;”.

Appellant has provided dictionary definitions of the words “arbitrarily” and “arbitrary” (see Appeal Brief, pages 16-17), however these definitions fail to clarify the claim language, and thus fail to assist in particular pointing out and distinctly claiming the invention. For example, based on the definitions provided, the arbitrarily long list of aspects could be determined: (1) at will, (2) based on choice or discretion, (3) arising from unrestrained exercise of the will, caprice or personal preference: (4) selected at random (5) based on random or convenient selection or choice rather than on reason or nature...etc. It would not be obvious to one of ordinary skill in the art whether a particular number chosen for the list of aspects of interest or meter descriptions would conform or contradict the arbitrarily or arbitrary definitions. For example, using a specified number of aspects of interest (Example: 5 most common) can be considered based on choice or discretion as in (2) above, but not at random, (4) above. Therefore it conforms to one definition of arbitrary but not another. Also, using a random number generator to determine the number of aspects of interest would satisfy the selected at random (4) above, but not based on choice or discretion, (2) above. Thus, two totally different methods for determining the number of aspects of interest could both be considered arbitrarily or not arbitrarily depending on which definition is applied. Therefore, depending on how “arbitrarily” or “arbitrary” is interpreted by definition, determines whether or not the number of aspects of interest can be considered “arbitrarily” as defined in the claim. Therefore, in this context, it would not be obvious to one of ordinary skill in the art how to interpret arbitrarily as used in the claims and therefore the metes and bounds of the claims are confusing.

Appellant has also cited various issued patents that use the term “arbitrarily long” or “arbitrarily large.” However, they are not read in the same context as the present claims. When read in context of the pending claims, the term arbitrarily renders the claim indefinite because it fails to particularly point out and distinctly claim the invention as discussed above.

For these reasons, the term “arbitrarily” is rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the invention.

Arbitrarily/arbitrary can be interpreted based on various definitions and consequently the metes and bounds of the claims are confusing and not obvious to one of ordinary skill in the art. Therefore claims 1-18, 20 and 23 stand rejected under 35 U.S.C. § 112, second paragraph.

B. Rejection of claims 1-7, 16, 17 and 19-23 under 35 U.S.C. § 102(e) as being anticipated by Maruta.

2. Regarding independent claims 1, 6, 19-21 and 23, Appellant asserts that Maruta fails to anticipate the claims because Maruta (1) is not configurable (see Appeal Brief, pages 23-24); (2) does not disclose a coded billing strategy including a list of aspects of interest and a list of meter descriptions (see Appeal Brief, pages 23-24); and (3) does not disclose allowing the list of aspects of interest and the list of meter descriptions to be “arbitrarily long” (see Appeal Brief, pages 24-25).

Note: Examiner would like to point out that Maruta is not a newly cited reference as stated by the Appellant (Appeal Brief, page 22).

In Response to (1): Regarding independent claims 1, 6, 19-21 and 23, Appellant’s argument that Maruta is not configurable is not persuasive. The recitation configurable billing

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system has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore there are no limitations in the body of these claims in which configuring a billing system is performed. Applicant's remarks regarding configuring a billing system refer to passages in the specification (see top of page 3) rather than the claims. While claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Independent claims 16 and 22 recite configurable in the body of the claim. However, Maruta does teach a configurable billing system. For example, Maruta teaches that the system has alternative structures (column 11, lines 4-18); can be implemented using different embodiments (column 11, see second embodiment); and furthermore it would be inherent that the software calculating the cost for printing could be updated for increased prices (column 10, lines 1-52). Also regarding claims 16 and 22, Appellant argues that Murata is directed towards events "prior" to printing a document (Appeal Brief, page 28). However, claims 16 and 22 are not limited to post printing and therefore this argument is not persuasive.

In Response to (2): Appellant's argument that Maruta does not disclose a coded billing strategy including a list of aspects of interest and a list of meter descriptions is not persuasive. Appellant argues that Maruta fails to disclose the coded billing strategy as depicted in various passages of the specification, pages 6-7, 10-12 and Figures 2 & 4 (see Appeal Brief pages 23-

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24). While claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Given the broadest reasonable interpretation, Maruta discloses a coded billing strategy. Maruta discloses the use of billing strategies such as how cost is calculated (column 9, lines 20-41 and column 10, lines 1-52). Maruta further discloses a cost calculation process using an initialization process a various determinations (column 21, lines 40 thru column 22, line 8). It is inherent that the software code is used in navigating through the determinations and performing the cost calculation. Furthermore, Murata also discloses the use of codes for carrying out the printing operations so that cost calculation can occur (column 19, lines 11-57 and Figure 24). Claim 1 does not further narrow the “coded billing strategy” and therefore the use of codes in organizing a printed product and to have the cost calculated reads on a “coded billing strategy” when given its broadest reasonable interpretation.

In Response to (3): Appellant’s argument that Murata does not disclose allowing the list of aspects of interest and the list of meter descriptions to be “arbitrarily long” is not persuasive. As discussed above in the 35 U.S.C. 112, second paragraph, the phrase “arbitrarily long” was rejected as being indefinite. The phrase was interpreted as being “at least one.” Therefore this argument is not persuasive.

For these reasons, Appellant’s argument that Maruta fails to disclose a configurable billing system, a coded billing strategy, and “arbitrarily long” is not persuasive. Therefore claims 1-7, 16, 17 and 19-23 under 35 U.S.C. § 102(e) as being anticipated by Maruta.

3. The Examiner now addresses the arguments raised by the Appellant with respect to the dependent claims.

Regarding claim 2, Appellant argues that the format teachings of Murata are related to images and not towards information regarding the aspects of interest. The Examiner respectfully disagrees. Cost calculation analyzes images to determine a cost associated with printing (column 9, lines 20-41). Furthermore, an image is information regarding the aspects of interest and the images are stored in various formats (column 11, lines 51-57). Furthermore, the image files are used in cost calculation since the printing cost corresponds to the printout of the image file (column 18, lines 22-34).

Regarding claim 3, Appellant argues that each meter in the list of meters is described as a function of at least one of the listed aspects of interest. Examiner respectfully disagrees. There are multiple aspects of interest (document size, ACS determination, number of documents) are each associated with meter descriptions (large/small, bland-white/color) and Murata further states that a counter corresponds to each type of document determined by the combination of document size and ACS determination (column 9, lines 20-41).

Regarding claims 4, 5, 7, 17 and 7, Appellant provides similar arguments to the ones discussed above and therefore these claims stand or fall with their independent claims.

Regarding dependent claims 8-15 and 18, the Examiner rejected these claims under 35 U.S.C. 103(a) in view of Murata and Official Notice. Appellant failed to challenge the use of the Official Notice in the subsequent reply and instead argued that the Murata failed to teach the limitations, which was already conceded by the Examiner. Therefore claims 8-15 and 18 remain rejected as previously stated and stand or fall with their independent claims.

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C. The Amendment to Claim 22 in Amendment E raises new issues.

Appellant argues that the amendment to claim 22 stating “document production events” does not raise new issues (see Appeal Brief, page 41).

In Response: The Examiner respectfully disagrees. Before the amendment, the claim stated “recording occurrences of document production.” This is interpreted as dependent upon actual document production. As amended in Amendment E, “recording occurrences of document production events” raises new issues because no longer is document production required, and instead could be an event associated with document production. Therefore the amendment raises new issues and was denied entry.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Stefanos Karmis
14 August 2007



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